

REMARKS

This Reply is in response to the Final Office Action mailed on June 11, 2007 in which claims 22-31 remain withdrawn from consideration; in which claims 41-58 were allowed and in which claims 1-4, 6, 33, 35 and 37-39 were rejected. With this response, claim 1 is amended to correct a typographical error. Claims 1-4, 6, 33, 35, 37-39 and 41-59 are presented for reconsideration and allowance. Because claim 1 is believed to be generic to the previous non-elected species, upon allowance of claim 1, Applicants respectfully request reinstatement of previously withdrawn claims 22-27 which depend from claim 1.

I. Examiner Interview Summary

On August 6, 2007, a telephonic interview was held between Examiner Koczo and Applicant's attorney, Todd A. Rathe. The rejection of the claims under 35 USC 112, first paragraph and second paragraph were discussed. Although no agreement was reached, Applicant wishes to thank the Examiner for the opportunity to discuss the rejections.

II. Claim Objections

Page 2 of the Office Action objected to claim one building a typographical error. In response, claim 1 is amended to correct this typographical error. Because no new issues are raised, Applicants respectfully request entry of the amendment to claim 1 to place the application in condition for allowance or in better form for appeal.

III. Rejection of Claims 1-4, 6, 33 and 59 under 35 USC 112, first paragraph

Page 3 of the Office Action rejected claims 1-4, 6, 33 and 59 under 35 USC 112, first paragraph as allegedly failing to comply with the enablement requirement. In particular, the Office action stated:

Claim 1 recites "at least one bias mechanism coupled to said one of the support in the first occlusion to resiliently bias said one of the support in the first occlusion towards a non--pumping position

while the at least one bias mechanism is out of contact with the first occlusion surface." This implies that the bias mechanism can be in contact with a first occlusion surface. There is no description in the application as originally filed a bias mechanism which can be in contact with a first occlusion surface.

(Office Action, p. 3) (Emphasis added).

However, as acknowledged by the Office Action, claim 1 does not specifically recite that the bias mechanism is in contact with a first occlusion surface. 35 USC 112 requires that the specification provide enabling support for the subject matter being claimed, NOT what may possibly be "implied" from the claim.

Although it may be true that the language of claim 1 recited by the Examiner leaves open the possibility that the bias mechanism may be in contact with the first occlusion surface at certain times, the language of claim 1 also leaves open the possibility that the bias mechanism is never in contact with the first occlusion surface. Claim 1 is simply broad. However, the fact that a claim is so broad so as to cover disclosed features as well as undisclosed features does not render the claim invalid under 35 USC 112, first paragraph.

In the present case, it appears that the Examiner has improperly applied an extremely narrow construction to claim 1 (improperly adding the additional limitation that the bias mechanism contact the first occlusion surface at times) in order to justify a rejection under 35 USC 112, first paragraph that this narrow feature is not shown. Once again, Applicant is not specifically claiming this narrower construction applied by the Examiner. The present disclosure does provide enabling support for the broad language of claim 1. 35 USC 112, first paragraph does not require that the disclosure provide support for each and every possible embodiment identified by the Examiner that may fall under the broad language of the claim. Accordingly, the rejection under 35 USC 112, first paragraph should be withdrawn.

IV. Rejection of Claims 1-4, 6, 33, 35, 37 and 39 under 35 USC 112, Second Paragraph

Page 2 of the Office Action rejected claims 1-4, 6, 33, 35, 37 and 39 under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.. In particular, the Office Action asserted that the scope of the claims cannot be clearly ascertained since the claims are not limited to the elected species. During the Examiner Interview held on August 7, 2007, the Examiner maintained his position that the rejected claims or improper as encompassing non-elected species.

Applicant respectfully requests that the rejection be withdrawn since (1) it is well settled law that alternative claim language is permitted and (2) the Markush style claims are entitled to full examination following the procedures set forth in MPEP 803.02.

A. Alternative Claim Language is Permitted.

Claims 1-4, 6, 33, 35, 37 and 39 recite functional relationships in the alternative. Such alternative claim language was included in the originally filed claims prior to the imposition of the restriction requirement. As noted in MPEP 2173.05(h), such alternative claim language is permitted. Claims 1, 35, 37 and 39 clearly meets the definition of a generic claim as set forth in MPEP 806.04(d).

B. The Markush Style Claims Are Entitled to Examination under MPEP 803.02

As noted in MPEP 2173.05(h), claims 1, 35, 37 and 39 comprise Markush style claims reciting features in the alternative. As noted in MPEP 803.02, “purely mechanical features or processes may also be claimed by using the Markush style of claiming.”

MPEP 803.02 sets forth the proper procedure for handling Markush type claims with regard to restriction practice. In particular, MPEP 803.02 recites:

In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. An examiner should set forth a requirement for election of a single disclosed species in a Markush-type claim using form paragraph 8.01 when claims limited to species are present or using form paragraph 8.02 when no species claims are present. See MPEP § 808.01(a) and § 809.02(a). Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. A second action on the rejected claims can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

On the other hand, should **>the examiner determine that< the elected species >is allowable<, the *>examination< of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be rejected and claims to the nonelected

species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species.

(MPEP 803.02) (Emphasis added).

During the Examiner Interview, the Examiner asserted that the rejection under 35 USC 112, second paragraph was proper because such claims would otherwise unfairly allow Applicant to "skirt" around the restriction requirement and would require the Examiner to search the nonelected species. However, as noted above, the procedure under MPEP 803.02 addresses the Examiner's concerns. Under the correct procedure, the Examiner need only examine the elected species first for the Markush style claim. If the elected species is deemed allowable, THEN the search must be extended to cover the nonelected species.

Applicant respectfully submits that the procedure for addressing Markush claims in restriction requirement as set forth in MPEP 803.02 has not been followed. Applicant requests (1) that the rejection of such claims under 35 USC 112, second paragraph be withdrawn, (2) that such claims be properly examined pursuant to MPEP 803.02 and (3) that the finality of the present office action be withdrawn to provide Applicant with a fair opportunity to respond to any new rejection of such claims.

V. Conclusion

After amending the claims as set forth above, claims 1-4, 6, 33, 35, 37-39 and 41-59 are presented for reconsideration and allowance. Because claim 1 is believed to be generic to the previous non-elected species, upon allowance of claim 1, Applicants respectfully request reinstatement of previously withdrawn claims 22-27 which depend from claim 1.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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